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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,219	12/24/2001	Eric A. Belec	F-444	5243

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EXAMINER

ALIE, GHASSEM

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/31/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,219

Applicant(s)

BELEC ET AL.

Examiner

Ghassem Alie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: _____

Election/Restrictions

1. Applicant's election of Invention I and species I in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 3-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a backing member as set forth in claim must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: a front wall 51, enclosed chamber 60, and opening 55. See page 6, line 26 and page 7, lines 5, and 9.

A proposed drawing correction or corrected drawings are required in reply to the office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The specification is objected to under 37 CFR 1.71 for not disclosing a backing member in conjunction with the vertical edges 861 defines a second cutting nip. See page

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14, lines 1-14.

6. The disclosure is objected to because of the following informalities:

Page 4, lines 17 and 18, page 6, line 4, and page 7, line 10, "a vacuum and HEPA filter system 17" should be --a vacuum and HEPA filter system 15--;

Page 7, line 12, "paddle 61" should be --paddle 62--;

Page 8, line 10, "A projection 93" should be --A projection 53--;

Page 13, line 22, "the slots 51" should be --the slots 851--; and

Page 14, line 27, "notches 55" should be --notches 855--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 8, the disclosure fails to teach what is a backing member and how the vertical edges and the baking member define a second cutting nip.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite or failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 8, it is not clear where is a backing member and how the backing member helps to create the second cutting nip. It is also not clear whether that mailpiece passes through the first cutting nip and the second cutting nip at same time or at a different time.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gall et al. (4,699,035). Regarding claim 1, Gall discloses device for perforating cutter that can be used for cutting mailpieces, the device includes a first cutter wheel 3 having a first cutting edge as shown in Fig. 3, a second cutter wheel 6 having a second cutting edge 19 and a plurality of notches 24 therein, and means 1, 2 to drive the first and second cutter wheels 3, 6 into rotation. Gall also discloses that the first and second cutter wheels 3, 6 are disposed to define a cutting nip between the first cutting edge and the second cutting edge 19 such that at times when a mailpiece passes through the cutting nip the interaction of the first cutting edge and the second cutting edge 19 is capable of cutting the mailpiece except when the plurality of notches 24 are present at the cutting nip. The cutting nip between the cutter wheels 3 and 6 is shown in Figs. 3 and 4. See Figs. 1-5 and col. 3, lines 1-60.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negative by the manner in which the invention was made.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gall in view of Cavagna (5,458,034). Gall teaches everything noted above except that the first cutting edge has at least a notch therein. Cavagna teaches an apparatus for 10 including a first cutter wheel 16 having a cutting edge, which has a notch 60 therein. The notch or groove 60 receives the cutting edge of the second cutter wheel 14. See Fig. 1 and col. 2, lines 19-54 and col. 4, lines 7-19 in Cavagna. It would have been obvious to a person of ordinary skill in the art to provide Gall's cutting device with the first cutter wheel as taught by Gall in order create a support surface for the materials passing through the nip between the cutting edges of the cutter wheels.

14. Claim 8, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Gall in view of Cavagna, as applied to claim 2, and in further view of Meaden et al. (3,978,752), hereinafter Meaden. Gall as modified by Cavagna teaches everything noted above except that the second cutter wheel includes a backing member having vertical edges, which define a second cutting nip jointly with the first cutting edge of the first cutter wheel and the vertical edges make a second cut on mailpieces perpendicular to the first cut made by the cutting edge of the second cutter wheel. Meaden teaches a second cutter wheel 12 including a backing member 12 having vertical edges 22, which are capable

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of defining a second cutting nip jointly with the first cutting edge of the first cutter wheel 16 as taught by Cavagna and the vertical edges 22 make a second cut 27 on mailpieces 24 perpendicular to the first cut 23 made by the cutting edge 19 of the second cutter wheel 12. See Fig. 1 in Cavagna and Fig. 1-4 and col. 3, lines 6-64 in Meaden. It would have been obvious to a person of ordinary skill in the art to provide Gall's cutting device, as modified above, with the baking member as taught by Meaden in order to cut the entire edge of the mailpiece.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Meaden et al. (3,978,753) disclose an adjustable perforator wheel.

Silver (3,463,039) discloses a knife for cutting tear-line in cardboard.

Schulz (4,444,080) discloses a tool for making rows of perforations in paper webs or the like.

Hillesheim (4,068,366) discloses a method and apparatus for producing opening in sheet material.

Smith (3,958,051) discloses a composite label web and method of making same.

Russ et al. (5,981,013) disclose a perforating blade/ label perforating.

Millared et al. (4,725,261) disclose a cutting carton blanks and cutters therefor.

Nassar (3,152,501) discloses a paper perforating attachment for printing press.

Nelson (5,188,504) discloses an envelope opener and load separator.

Montrose (5,117,721) discloses a method of forming perforating rule and blades.

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Kanbe (6,302,605) discloses a rotary cutter apparatus for printer with full and partial cutting modes.

Stevens et al. (5,464,099) disclose a method for the automated processing of documents and bulk mail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (703) 305-4981.


The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (703) 305-1082. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

GA/ga

July 21, 2003


Allan N. Shoap
Supervisory Patent Examiner
Group 3700